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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
|--|-------------|----------------------|-------------------------------|------------------------|
| 09/979,570   | 11/26/2002  | Marvin A. Frenkel    | MAF-10002/22                  | 6028                   |
| 27572 7590 10/31/2007<br>HARNESSE, DICKEY & PIERCE, P.L.C.<br>P.O. BOX 828<br>BLOOMFIELD HILLS, MI 48303 |             |                      | EXAMINER<br>AUGUSTIN, EVENS J |                        |
|  |             |                      | ART UNIT<br>3621              | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>10/31/2007       | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/979,570             | FRENKEL, MARVIN A.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Evens Augustin         | 3621                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,5,7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Acknowledgement*

1. The USPTO has considered applicant's arguments/remarks and has found them to be persuasive. As a result, a new office action is in order. Claims 1, 5, 7 and 10 are pending.

### *Claim Interpretation*

2. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.
3. It should also be noted that, in the office action that:
  - A. Items in the rejection that are in quotation marks are claimed language/limitations.
  - B. Passages in prior art references may be mere rephrasing/rewording of claimed limitations, but the implicit/explicit meaning of the references vis-à-vis the claimed limitation remains intact.
  - C. Functional recitation(s) using the word "for" or other functional terms have been considered but given less patentable weight<sup>1</sup> because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v.*

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<sup>1</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

*Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

- D. Limitations that recite the purpose of a process or the intended use of a structure are generally not given any patentable weight. Patentable weight is therefore given to the actual process steps or structural limitations.
- E. Word(s) that are separated by “/” are being examined as being synonymous or equivalent.
- F. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.
- G. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

- H. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.
- I. The USPTO interprets common computer related words that are not lexicographically defined, in accordance to Computer Dictionary, 3<sup>rd</sup> Edition, Microsoft Press, Redmond, WA, 1997<sup>2</sup>. The USPTO also uses published patent applications and issued patents as well, for meanings of common computer related words that are not lexicographically defined.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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<sup>2</sup> Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" to define the term "flag." See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled 'New Terminology.'

5. Claims 1, 5, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al. (U.S. 6505171).
6. As per claims 1, 5, 7, Cohen et al. discloses an invention that relates generally to transactional systems and methods and more specifically to systems and methods for purchasing goods and or services over a global computer network. The invention comprises of the following:
  - A. The user exchanging currency/cash for a prepaid card (C3, LL.31-34) – that way, the purchase remains anonymous (C2, LL.22-25)- (**"a customer depositing cash with a depository, the depository being independent of said customer such that the identity of said customer remains anonymous"**)
  - B. The cash used to purchase the pre-paid card is used for online purchases (C.6, ll.62-67)- the card has a unique identifier/serial number (C.5, ll.17-19) --(**"converting said cash into electronic currency, setting up a numbered account and placing said electronic currency into said numbered account"**)
  - C. The serial number on the card is randomly generated (C. 5, ll. 5-6 and 15-16) -- (**"issuing to the customer one or more anonymous and randomly-generated serial numbers corresponding to the account number"**)
  - D. Submitting card ID to merchant (C. 8, ll. 33-35) --("submitting at least one serial number to the on-line merchant to purchase goods or services, said on-line merchant and said depository being unable to identify said customer during said purchase ")
  - E. The appropriate information is then submitted electronically (computer readable is inherent) to payment server for verification / authentication during the online

transaction (C. 8, ll.49-65) --(**"transferring an amount of said electronic currency corresponding to said at least one serial number to an account of said on-line merchant"**) --(**" transmits said serial number to a server of said depository for authentication"**)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (U.S. 6505171), in view of DiMaria et al. (U.S. 6148091).

As per claim 10, Cohen et al.' s invention has previously been disclose.

Cohen did not explicitly describe a method/system in which serial number/unique identifier comprises information/data about the customer's age. However, DiMaria et al. describes an invention that relates to accessing personalized identification information and encoded age data stored in at least one machine readable medium on an individual's identification document, such as a driver's license or other official document, to determine whether an individual is of legal age. According to DiMaria et al., age data is encoded into a machine readable surface (column 2, lines 61-65). The surface can be anything, printed, written,

encoded, etc., which is relied upon to record data or provide identification (column 3, lines 42-45).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would employ a method/system in which serial number/unique identifier comprises information/data about the customer's age. According to DiMaria et al. the motivation would be to provide an inexpensive method and apparatus to check age data on a bearer's identification document and to alert an operator as to whether the bearer may purchase or rent age-controlled merchandise or services (column 3, lines 12-15).

### ***Conclusion***

8. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*



9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/  
Evens J. Augustin  
October 28, 2007  
Art Unit 3621